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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/343,823	06/30/1999	CHARLES CALVIN BYERS	42430-10625	8359

7590

02/11/2004

Patent Docket Clerk  
Jenner & Block, LLC  
One IBM Plaza  
Chicago, IL 60611

EXAMINER
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LE, DANH C

ART UNIT	PAPER NUMBER
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2683

23

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/343,823

Applicant(s)

BYERS ET AL.

Examiner

DANH C LE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,10-14 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10-14 and 18-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-5, 7, 18-21, 23, 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liao (US 6,292,833) in view of Shefi (US 6,445,794).

As to claim 1, Liao teaches a telecommunications network (figure 1) which transmits or receives data in the secure environments, comprising:

a customer premise equipment (106) coupled to a terminating network node (col.3, lines 21-36);

an originating network node (108) connected to the terminating network node (106) via at least one other network node (104); and

said at least one other network node (104) equipped with a processor (col.4, lines 38-40) for transmitting a message to the customer premise equipment (106) via the terminating network node, the deny message indicating to a user of the customer premise equipment that a link that does not have private or encrypted information or that uses facilities not absolutely controlled by a network provide (col.5, line 65-col.6, lines 21, col.9, line 62-col.10, line 24, a message is denied is sent to the local service of the mobile devices that the link is not secure which means a link that does not have

private or encrypted information or that uses facilities not absolutely controlled by a network provide, col.6, lines 5-6).

Liao fails to teach the message indicates to the user when the data was transmitted or received in the insecure environment. Shefi teaches the message alerts to the user when the data was transmitted or received in the insecure environment (col.19, line 55-col.20, line 240). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Shefi into the system of Liao in order to alert the mobile user the transmission subject to interception.

As to claim 3, Liao teaches the telecommunications network of claim 1 wherein the originating network node alerts a calling party using a customer premise equipment coupled to the originating network node of presence of said non-private link (col.11, lines 34-40).

As to claim 4, Liao teaches a method for providing secure transmissions in a telecommunications network (figure 1) comprising the steps of:

establishing a route from an originating network node (108) to a terminating network node (106);

determining whether at least a portion of the route includes a link that does not send or receive private or encrypted information or that uses facilities not absolutely controlled by a network provide (figure 5, 510, col.5, line 65-col.6, lines 21); and

responsive to the step of determining whether at least a portion of the route includes the link (col. 11, lines 20-40). Liao fails to teach prior to connection to said

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terminating network node, providing an alert of a security status of the route to a calling party using the originating network node. Shefi teaches prior to connection to said terminating network node, providing an alert of a security status of the route to a calling party (col.19, line 55-col.20, line 44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Shefi into the system of Liao in order to alert the mobile user the transmission subject to interception.

As to claim 5, Liao teaches the method of claim 4 further comprising the step of: completing a call after the alert has been provided (figure 5, steps 510-516).

As to claim 7, the combination of Liao and Shefi method of claim 4 wherein providing the alert includes issuing a message on an identification display associated with one of a station associated with the terminating network node and the calling party (Shefi, col.19, line 55-col.20, line 44).

As to claim 18, Liao teaches telecommunications system (figure 1) comprising: means for interconnecting a sender and recipient (102,110); and

means for alerting the a sender and recipient when a call path is using at least a link that does not send or receive private or encrypted information or that uses facilities not absolutely controlled by a network provide (col.5, line 65-col.6, lines 21, col.9, line 62-col.10, line 24).

Liao fails to teach the sender is a calling party and the recipient is a called party. Shefi teaches the sender is a calling party and the recipient is a called party (col.19, line 55-col.20, line 44). Therefore, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to provide the teaching of Shefi into the system of Liao in order to alert the mobile user the transmission subject to interception.

As to claim 19, Liao teaches the telecommunications system of claim 18 wherein the call path traverses a packet data network (col.4, lines 38-40).

As to claim 20, Liao teaches the telecommunications system of claim 18 further comprising means for determining whether the link has been traversed (col.11, lines 16-20).

As to claims 21, Liao teaches the telecommunications system on claim 18 further comprising means for issuing insecure link alert signals to other elements in a telecommunications network (col.11, lines 16-28).

As to claim 23, Liao teaches the telecommunications system of claim 18 wherein the call path traverses a cell network (figure 1).

As to claim 25, Liao teaches a method for providing secure transmissions in a telecommunications network (figure 1) comprising the steps of:

establishing a route from a sender to a recipient (a router from mobile 102 to remote server 110);

determining whether at least a portion of the route includes a link that does not send or receive private or encrypted information or that uses facilities not absolutely controlled by a network provide (col.5, line 65-col.6, lines 21, col.9, line 62-col.10, line 24)

responsive to a positive result in said determining step, further determining whether a secure connection may be established between said sender and said

recipient (a secure indicator message forward to requesting mobile device at steps 510, 514, 516 of figure 5); and

responsive to a positive result in said determining step and a negative result in said further determining step, providing an alert of the insecure nature of the route to the sender (an insecure indicator message forward to requesting mobile device step 512, 516 of figure 5).

Liao fails to teach the sender is a calling party and the recipient is a called party. Shefi teaches the sender is a calling party and the recipient is a called party and providing an alert of the insecure nature of the rout to the user (col.19, line 55-col.20, line 44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Shefi into the system of Liao in order to alert the mobile user the transmission subject to interception.

As to claims 26-27, the combination of Liao and Shefi teaches method of claim 25 wherein said telecommunications network includes at least one intermediate node in said route from said calling party to said called party, and wherein step above thereof further comprises the step of:

transmitting a message including a security status request through each of said at least one intermediate node (Liao, Figure 6, shows a message including status request transmit from network gateway 612 through carrier network 614 to mobile device 616).

Liao also teaches a message can be instead be supplied to the network gateway by remote server (intermediate node, step 503 of figure 5), if such node is insecure, receiving a message indicating such node is insecure (steps 512, 516 of figure 5).

As to claim 28, the combination of Liao and Shefi teaches method of claim 25 further comprising the step of:

establishing a secure connection between said calling party and said called party (Liao teaches as soon as the secure connection is establishes down load authorized service identities from network gateway, figure 2).

As to claim 29, the combination of Liao and Shefi teaches the method of claim 25 further comprising the step of:

establishing a connection between said calling party and said called party despite a determination that a secure connection cannot be established (Shefi, col.19, line 55-col.20, line 44).

As to claim 30, the combination of Liao and Shefi fails to teach method of claim 25 wherein said alert is provided to said calling party, and the method further comprises the steps of:

receiving authorization from said calling party, after said calling party has received said alert, to maintain a connection between said calling party and said called party (col.19, line 55-col.20, line 45).

As to claim 31, the combination of Liao and Shefi teaches the method of claim 25 wherein said alert is provided to said calling party, and further comprises the steps of:

receiving authorization from said calling party, after said calling party has received said alert, to establish a connection between said calling party and said called party (col.19, line 55-col.20, line 45).



2. Claims 6,11-12,14, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liao and Shefi in view of Zicker et al (US 5,862,475).

As to claims 6, 11-12,14, 22 and 24, the combination of Liao and Shefi teaches a method for providing security transmissions in communication network on claim 4 above. The combination of Liao and Shefi fails to teach an alert in the system above including a distinctive ring at the recipient's station, an audible voice message, an audible tone, providing a periodic alert, a query screen on a personal computer, warning signals throughout the call and special parameters for a particular subscriber. Zicker teaches an alert in the system above including a distinctive ring (col.3, 13-20) at the recipient's station, an audible voice message (co.39, lines 42-47), an audible tone (col.40, lines 57-62), providing a periodic alert (col.14, lines 34-38), a query screen (col.24, lines 35-44) on a personal computer, warning signals throughout the call (col.40, line 55-col.41, line 10) and special parameters for a particular subscriber (col.15, lines 5-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Zicker into the system of Liao and Shefi in order to provide a variety of mechanism for alerting the caller or recipient of the insecure nature.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liao et al (US 6,292,833) and Shefi (US 6,445,794).

As to claim 13, the combination of Liao and Shefi teaches a method for providing secure transmissions in a telecommunications network on claim 4 above. The combination of Liao and Shefi fails to teach that the system issues an alert when a

previously secure route becomes insecure. However, it is obvious that when the network site is insecure, then the network site will be denied by the system and an alert message will be issued. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide alert message when a previously secure route becomes insecure into the system of Liao and Shefi in order to alert the mobile user when a previously secure route becomes insecure.

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liao and Shefi in view of Galvin (US 6,134,315).

As to claim 32, the combination of Liao and Shefi teaches the method of claim 25. The combination of Liao and Shefi fails to teach establishing a new route between said calling party and said called party. Galvin teaches routing system for provide routing between calling party and called party (col.4, lines 10-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Galvin into the system of Liao and Shefi in order to provide alternative new route between the calling party and called party.

### ***Response to Arguments***

Applicant's arguments filed 11/24/03 have been fully considered but they are not persuasive.

On page 8, paragraph 4 of the Applicant's remark, the Applicant argues that Liao and Shefi fails to disclose alerting the user to receipt of a transmission over a link a link that does not send or receive private or encrypted information or that uses facilities not absolutely controlled by a network provide.

In response, the examiner did not agree, Liao teaches message indicates to a user when link is not secure which means encrypted information or that uses facilities not absolutely controlled by a network provide (col.5, line 65-col.6, lines 21, col.9, line 62-col.10, line 24, a message is denied is sent to the local service of the mobile devices that the link is not secure which means encrypted information or that uses facilities not absolutely controlled by a network provide, col.6, lines 5-6) and Shefi teaches the message alerts to the user when the data was transmitted or received in the insecure environment (col.19, line 55-col.20, line 240).

On page 3, paragraph 1 of the Applicant's remark, the Applicant argues that Liao fails to teach the security status is made available to the user of the communication device.

In response, the examiner believes that Shefi teaches the security status is made available to the user of the communication device (col.20, lines 12-24).

On page 9, paragraph 2 of the Applicant's remark, the Applicant argues that there is no motivation to combine Liao and Shefi.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Liao discloses a

security status of the transmission link being report to a mobile device. The mobile communication device then uses the status to make decision regarding transmission receive over that link. Shefi teaches the user can make decision in light of the security status either secure or non-secure (col.20, lines 12-24). Since both Liao and Shefi providing the secure communication between two parties over a communication network,

Therefore, the combine of Liao and Shefi are obvious which enhances system performance of Liao for providing access control to Local services of mobile devices instead of closing the access to the local service of the mobile when the system acknowledges that the link is not secure after alerting the user, the system still opens access if the user is connected or closes when the user is disconnected.

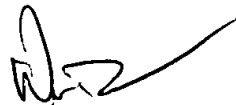
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C LE whose telephone number is 703-306-0542. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Danh C. Le



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